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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/623,713	07/22/2003	Paul G. Duncan	37724.011900D1	4935
22191	7590	03/25/2005	EXAMINER BARAN, MARY C	
GREENBERG-TRAURIG 1750 TYSONS BOULEVARD, 12TH FLOOR MCLEAN, VA 22102			ART UNIT 2857	

DATE MAILED: 03/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/623,713

Applicant(s)

DUNCAN ET AL.

Examiner

Mary Kate B. Baran

Art Unit

2857

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2004.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-17 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 22 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-15 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-14 of prior U.S. Patent No. 6,670,810. This is a double patenting rejection.

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 16 and 17 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 15 and 16 of U.S.

Patent No. 6,670,810. Although the conflicting claims are not identical, they are not patentably distinct from each other.

With regards to claim 16, claim 16 of the instant application recites the limitation "measuring at least one aspect of the environment in proximity to said remote sensing unit" whereas claim 15 of the patent recites the limitation, "using at least one optical sensor to measure at least one aspect of the environmental parameters in proximity to said remote sensing unit." There is no functional difference between the two limitations, as both recite measuring an aspect of the environment in proximity to the remote sensing unit.

The instant application further recites the limitation "transmitting said data to a host terminal" whereas the patent recites the limitation, "using a two way telemetry means to transmit and receive data from a host terminal." There is no functional difference between these two limitations, as both teach transmitting data to a host terminal.

The patent also recites the additional limitation of, "monitoring said remote sensing unit for evidence of tampering function." While this limitation is not recited in the application, the same method for remote sensing is performed by both the patent and the instant application.

With regards to claim 17, claim 17 of the instant application recites the same limitations as claim 16 of the patent.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 6-9, 11, 12, 16 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Carney (U.S. Patent No. 5,473,322).

Referring to claim 1, Carney teaches a remote sensing unit (see Carney, column 7 lines 53-65), comprising: at least one sensor, for measuring various aspects of the environment in proximity to a sensing unit (see Carney, column 4 lines 40-43); at least one signal processor, for processing measurements from said at least one sensor (see Carney, column 6 lines 1-7); a two-way telemetry function, for sending data to and receiving data from a host terminal (see Carney, column 7 lines 53-65); a tamper detection system for determining when said remote sensing unit has been opened (see Carney, column 4 lines 46-48); at least one controller, for storing results from said at least one signal processor, controlling power availability to selected devices associated with said remote sensing unit, and for processing data from said host terminal (see Carney, column 6 lines 1-7); and at least one power supply, for distributing controlled power to selected devices associated with said remote sensing unit (see Carney, column 5 lines 10-22).

Referring to claim 2, Carney teaches that the at least one sensor is an optical sensor (see Carney, column 4 lines 40-43).

Referring to claim 3, Carney teaches that said optical sensor can detect electrical current flow (see Carney, column 4 lines 36-43).

Referring to claim 6, Carney teaches that at least one controller includes a microprocessor (see Carney, column 6 lines 1-7).

Referring to claim 7, Carney teaches that at least one controller can control power distribution from said one or more power supplies to other remote sensing unit components (see Carney, column 5 lines 10-22).

Referring to claim 8, Carney teaches that at least one power supply receives traditional electrical power (see Carney, column 5 lines 10-22).

Referring to claim 9, Carney teaches that at least one power supply receives power from an alternative energy source (see Carney, column 7 lines 7-15).

Referring to claim 11, Carney teaches that two-way telemetry function is comprised of plain old telephone service (see Carney, column 7 lines 53-57).

Referring to claim 12, Carney teaches that two-way telemetry function is comprised of a wireless, point to point radio frequency interface (see Carney, column 7 lines 57-61).

Referring to claim 16, Carney teaches a remote sensing method (see Carney, column 7 lines 53-65), comprising the steps of: controlling power available to selected remote sensing unit components (see Carney, column 5 lines 10-22); measuring at least one aspect of the environment in proximity to said remote sensing unit (see Carney, column 4 lines 40-43); processing and storing said at least one measured aspect as data (see Carney, column 6 lines 1-7); and transmitting said data to a host terminal (see Carney, column 7 lines 53-65).

Referring to claim 17, Carney teaches defining appropriate intervals during which said controlled power is available to said remote sensing unit components based on control information received from said host terminal (see Carney, column 6 line 58 – column 7 line 6).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10 and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carney (U.S. Patent No. 5,473,322) in view of Gaukel (U.S. Patent No. 6,072,396).

Referring to claim 10, Carney teaches all the features of the claimed invention except that said two-way telemetry function includes one or more cellular telephone interfaces.

Gaukel teaches that said two-way telemetry function includes one or more cellular telephone interfaces (see Gaukel, column 7 lines 35-38).

It would have been obvious at the time the invention was made to one of ordinary skill in the art to modify Carney to include the teachings of Gaukel because utilizing cellular telephone interfaces would have allowed the skilled artisan to accommodate greater communication traffic (see Gaukel, column 7 lines 63-65).

Referring to claim 13, Carney teaches all the features of the claimed invention except that said two-way telemetry function is comprised of a wireless satellite interface.

Gaukel teaches that said two-way telemetry function is comprised of a wireless satellite interface (see Gaukel, column 7 lines 39-42).

It would have been obvious at the time the invention was made to modify Carney to include the teachings of Gaukel because utilizing a wireless satellite interface would have allowed the skilled artisan to accurately determine position (see Gaukel, column 7 lines 39-43).

Referring to claims 14 and 15, Carney teaches all the features of the claimed invention except that said position determination device is a global positioning system.

Gaukel teaches that said position determination device is a global positioning system (see Gaukel, column 7 lines 35-38).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Carney to include the teachings of Gaukel because having a global positioning system would have allowed the skilled artisan to determine and store location data (see Gaukel, column 3 lines 57-59).

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(a) Sears teaches an apparatus for communicating utility usage-related information from a utility usage location to a utility usage registering device.

(b) Johnson et al. teach a radio communication network for remote data generating stations.

(c) Schanker et al. teach a remote data acquisition and communication system.

(d) Lynch et al. teach a telemetry system for water and energy monitoring.

(e) Swanson teaches an ambient light filter.

(f) Long et al. teach an integrated system for gathering, processing and reporting data relating to site contamination.

(g) White et al. teach telephone dial-inbound data acquisition system with demand reading capability.

(h) Brunius et al. teach an automatic/remote RF instrument reading method and apparatus.

(i) Chance et al. teach a system and method for remote monitoring of cathodic protection systems.

(j) Pascalidis teaches a remote input/output smart sensor analog digital chip.

(k) Payne et al. teach a method and apparatus for power measuring.

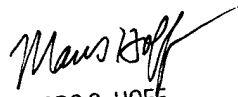
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Kate B. Baran whose telephone number is (571) 272-2211. The examiner can normally be reached on Monday - Friday from 9:00 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marc S. Hoff can be reached on (571) 272-2216. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2857

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

20 March 2005


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